



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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DEC - 6 2001

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#14

In re Application of
Patrice Debregeas et al
Serial No.: 312,485
Filed: May 17, 1999
Attorney Docket No.: 65691/163

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: PETITION DECISION
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This is in response to applicants' petition under 37 CFR 1.181, filed October 4, 2001, to withdraw the finality of the last Office action.

A review of the file history shows that the above identified application was filed May 17, 1999. Following a preliminary amendment which mainly removed multiple dependency and made other minor corrections to the claims, the examiner issued a first Office action on October 11, 2000, in which all of the claims were rejected for various reasons with specific rejections under 35 U.S.C. 112, second paragraph for indefinite phrases, such as "characterized by", etc., and suggesting they be corrected to more definite phrases, such as "consisting essentially of". The claims were also rejected under 35 U.S.C. 102(b) and under 35 U.S.C. 103(a) over various references.

Applicants replied on March 20, 2001, revising the claims as suggested by the examiner to include standard claim terminology, but without making any substantive changes to the scope of the claims, and arguing the rejections. The examiner issued a second Office action on May 31, 2001, acknowledging applicants' amendments by withdrawing all of the rejections under 35 U.S.C. 112. The rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103 of the previous Office action were maintained and new grounds of rejection under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) were set forth based on a reference provided by applicants in an information disclosure statement on August 3, 1999. The Office action was made Final.

Applicants replied to the Office action on August 30, 2001, requesting that the Finality be removed since the new grounds of rejection were not necessitated by applicants' amendments as alleged by the examiner. The examiner issued an Advisory action on September 21, 2001, maintaining the Finality and refusing entry of the amendment. This petition followed.

Applicants state that the new rejections under 35 U.S.C. 102(b) and 325 U.S.C. 103 were not necessitated by amendments to the claims since the only significant amendments made were those suggested by the examiner and applicants should not be penalized for following the examiner's directions. Further the references used were presented to the examiner prior to first action or cited by the examiner in the first Office action and, if appropriate for use in additional rejections, should have been utilized at that time so that applicants have a full and fair opportunity to address all proposed rejections.

Applicants' are correct in their assertions. A review of the file shows little substantive change to the claims such that a new reference already of record would be needed to reject the claims. In view thereof the Finality of the Office action of May 31, 2001, was improper and is hereby withdrawn. The reply filed August 30, 2001, will be treated as a reply to a non-Final Office action and the amendments to the claims will be entered

In view of the above, applicant's petition is **GRANTED**.

The application will be returned to the examiner for further consideration not inconsistent with this decision.

There is no fee for this petition and the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 19-0741, as directed.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230



John Doll
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